

## **REMARKS**

### **Claim Rejections under 35 U.S.C §102**

The Examiner's rejection of Claims 25, 27, 28, 29-46 and 50-51 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,174,235 to Walker, ("Walker") is respectfully traversed for at least the reasons given below.

Walker discloses a punchboard-type game having a number of elements and an equal number of locations. Col. 6, lines 49-54; Col. 7, lines 3-15. *Each* element is randomly assigned to a different location and is hidden from the player. Col. 7, lines 1-24. Each location is hidden or obscured until selected by the player. Col. 7, lines 7-10. Once the player selects the location, the element is immediately revealed. According to Walker's claimed invention, each element is randomly assigned to *at least one location*; thus, *each* element of the entire set of elements is assigned to at least one of the thirty-six locations. Col. 7, lines 16-21. Therefore, each element of the set of elements is present on the punchboard, whether the player selects it or not. There is no pure random assignment. There is no possibility of one indicium being assigned to all locations, or to none.

Applicants' Claims introduce an abundance of locations (spots, reels, etc.), where a player can select which locations will be used for a gameplay condition to ultimately determine an outcome. The player must select at least one location for a gameplay condition. After the player selects the locations (or reels), the locations are played (e.g., the reels are spun) to reveal the game element indicia for the respective location.

The game element indicia displayed for each location is one of a set of game element indicia. In contrast to anything disclosed in Walker, or any of the prior art, a complete set of game element indicia is available for assignment with each location; after the locations are selected and played, one game element indicium of the set will be displayed. In Applicants' game, and most distinctive from Walker, each *indicium of the set* of game element indicia will *not* necessarily be assigned to a single location somewhere on the "board", but rather are randomly available *to each of* the game element locations. Thus, one indicium of the full set of game elements could occur only once (e.g., a single pineapple), or it would be possible, for

example, for *all* game element locations to come up as the same single indicium (e.g., all pineapples). Further, a game element indicium may not be assigned to *any* of the game element locations. This adds an entirely new and exciting dimension to the game, since now multiples of the same indicium appearing at a plurality of locations is reproduced as a play factor. Hence, the name “spin keno” has been used by the Applicants for this aspect of the game, since it is an innovative hybridization of slots and keno.

The Examiner is incorrect in that “[n]ewly added limitation ‘one of a set of element indicia’ is taught by Walker in reference character group 102-110. Possibility of an indicia not being determined by the random process is clearly taught in Fig. 4, wherein \$50 indicia is not selected by the random process.”

Walker points out that Fig. 4 illustrates a so-called prior art conventional punch card that has selected elements from a group that does not contain all possible elements of a game. Col. 6, lines 40-46. (Again, Walker states for his game, “[b]y contrast, in the present invention the set from which the player selects includes all possible outcomes of a game”. Col. 6, lines 46-48. Thus, each of the elements 102, 104, 106, 108 and 110 is assigned to at least one of the plurality of locations 120. Col. 6, lines 55-57). There is nothing related to the Fig. 4 disclosure, however, which teaches or even implies any random assignment of one from the entire set of game element indicia being available with each location. It is completely silent as to how the punchboard comes to be composed without the \$50 game element, or with any of the other game elements for that matter.

Such pure randomization for each selection would, in fact, be anathema to the very concept of a punchboard, which is intended to include “no winner” locations (and not all \$50 winners).

The claims have been amended to further clarify this pure randomization for at least each selected location. The previous amendment perhaps did not capture this concept as clearly as now, and it is hoped that the Examiner can now see the great distinction over the prior art presented in the claims, and the lack of any such teaching in the art.

For the reasons stated above, Walker fails to disclose each and every element of the independent Claims and dependent Claims thereon concerning Claims 25, 27, 28, 29-46 and 50-

51. Thus, these claims cannot be anticipated by Walker since each and every element of the claimed invention is not disclosed. Further, Walker does not include any suggestion to modify the game to arrive at Applicants' invention; Walker teaches away from pure randomization. Accordingly, it is respectfully requested the rejection be withdrawn.

The Examiner's rejection of Claims 25, 27, 28, 29-46 and 50-51 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,149,156 to Feola ("Feola") is respectfully traversed for at least the reasons given below.

Feola discloses a multiple round card game of chance having a grid of 52 locations representing the number of cards in a standard 52-card deck of playing cards, i.e., the grid has one card location for each card. Col. 5, lines 10-13 and 39-41. In one form, the player first places a wager for play and selects five locations on the grid to form a five card poker hand. Col. 6, lines 16-19. After the player selects locations, the cards are immediately revealed, or alternately all 52 cards are revealed. Col. 6, lines 19-22. Payouts are based on how the hand formed from the cards revealed in the chosen locations compares to the payout schedule. Col. 6, lines 24-25.

As described above, Applicants' Claims introduce an abundance of locations (spots, reels, etc.), where the game element indicia displayed for a location is in each instance one of a complete set of game element indicia. That is, a full set of game element indicia is associated with each location. Again, even if one of the indicia of the full set of game element indicia occurred only once (pineapple), it would be possible for all game element locations to come up as the same single indicium (e.g., all pineapples) just as a game element indicium may result in a game element indicium from said set to not be assigned to any of the plurality of game element locations as recited in previously amended independent claims 25, 29, 39 and 50.

In contrast to the present invention, and like Walker (described above), the game element indicium in Feola displayed for each location can be but one of a set of game element indicia assigned to *at least one location* on the board (or matrix). Col. 2, lines 12-15; Col. 5, lines 10-12; Claim 1; Claim 16. Only one card of the set of game cards is associated with a location when played, i.e., there is one card location for each card. Claims 1, 16 and 22. Multiples of the identified card do not appear. Again, in the present invention, the game element indicia are

randomly available to each of the game element locations making it possible for a game element indicium not to occur or be assigned to any of the game element locations as recited in previously amended independent Claims 25, 29, 39 and 50. Thus, in Applicants' game, one of the indicia -- the Jack of Hearts -- of the full set of game element indicia -- the entire set of cards -- could appear at all selected gameplay locations. Nothing like this is shown or suggested in Feola, and would lead to chaos in Feola's game, i.e., Feola teaches away from Applicants' game.

A further distinction of Feola, like Walker, from the present invention is that the elements are assigned before a player selects locations for gameplay whereas in the present invention locations are selected prior to the random assignment of indicia.

For the reasons stated above, Feola fails to disclose each and every element of the independent Claims and dependent Claims thereon concerning Claims 25, 27, 28, 29-46 and 50-51. Thus, these claims cannot be anticipated by Feola since each and every element of the claimed invention is not disclosed. Further, Feola does not include any suggestion to modify the game to arrive at Applicants' invention. Accordingly, it is respectfully requested the rejection be withdrawn.

### **Claim Rejections under 35 U.S.C §103**

The Examiner's rejection of Claims 26, 47-48, 52 under 35 U.S.C. § 103(a) as being unpatentable over Walker is respectfully traversed for at least the reasons given below.

Walker is described and distinguished above.

Claim 26 depends from Claim 25. Since Claim 25 should be allowable for the reasons above, then Claim 26 should also be allowable since it is a dependent Claim of an allowable Claim.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) Claim 47 recites a slot type gaming machine using a spinning reel visual presentation, wherein the player selects reels limited to less than all of the reels. The reels are spun to randomly arrive at and reveal game element indicium for each reel.

One of ordinary skill in the art at the time Walker was made would not have suggested selecting locations in a conventional environment with reels because Walker is a punchboard-type game. Walker discloses a punchboard-type game with thirty-six locations. Col. 7, lines 19-20. It would not have been obvious to use a reel for each element location in a punchboard-type game. Further, Walker does not supply all of the claim limitations or provide some teaching, suggestion or motivation to modify the reference to supply all of the claim limitations of Claim 47.

Additionally, Claim 52 depends from Claim 50. Since Claim 50 should be allowable for the reasons above, then Claim 52 should also be allowable since it is a dependent Claim of an allowable Claim.


Therefore, for at least the foregoing reasons, reconsideration of the rejections is respectfully requested. A Notice of Allowability is solicited.

If the Examiner maintains his rejections after considering the foregoing, Applicants respectfully request an interview to further clarify the arguments stated herein.

Respectfully submitted,

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